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DAILEY, THOMAS J				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/720,034

**Applicant(s)**

BATTLE ET AL.

**Examiner**

THOMAS J. DAILEY

**Art Unit**

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-15, 17-30, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-15, 17-30, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 12, 16, and 31 were cancelled.
2. Claims 1-11, 13-15, 17-30, 32, and 33 are pending in this application.

### ***Response to Arguments***

3. The applicant has indicated that claim 8 (previously rejected under U.S.C. 112 2<sup>nd</sup> paragraph) is clearly a dependent claim. The claim, however, is acceptable only if it is interpreted as independent claim, due to the fact it is an improper dependent claim as it does not further limit the parent claim (specifically, claim 1 is a method claim and cannot be further limited by a computer readable media claim) and if the applicant intends to further prosecute claim 8 additional fees are due, as this would give the instant application 6 independent claims, and the applicants have only filed appropriate fees for 5 independent claims. See MPEP 714.10 and 37 CFR 1.16(h).
4. Applicant's arguments with respect the prior art rejections of the claims 1-10 and 15-33 have been considered but are moot in view of the new ground(s) of rejection.
5. Applicant's arguments with regards to the prior art rejections of claims 11-14 have been fully considered but they are not persuasive.

6. The applicant argues with respect to presently amended claim 11, that Gazzetta (US Pub. 2004/0083297) fails to disclose the gateway server verifying that the user is authorized to participate in public IM communications (essentially the content of the previously presented and now cancelled dependent claim 12).
7. The examiner disagrees. Gazzetta discloses the gateway server verifying that the user is authorized to participate in public IM communications ([0038], lines 10-15 and [0039], lines 7-17, authentication server (gateway server) verifies via the service provider that the user is authorized to connect with the service provider (public IM communications)).

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 15-29 are rejected under 35 U.S.C.101 because the claimed invention is directed to non-statutory subject matter.
10. Claim 15 recites, "A system comprising...a public instant message service...an instant message connect domain store...a dispatch server." The system given the recited limitations in the claim and interpreted in light of the specification, can reasonably be interpreted and implemented as software alone; thereby making

the claim functional descriptive material that is not tangibly embodied on a computer system or computer storage medium which is non-statutory.

11. Claims 16-29 depend from claim 15 and do not remedy the rejection provided above.

***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 15-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
14. Claim 15 recites, "a dispatch server configured to: receive a connection request from a user (lines 11-12)...determine whether the connection request is being received from an instant message gateway server (lines 13-14)...in an event that the connection request is not being received from an instant message gateway server (lines 15-16)." It is unclear what "determine[ing] whether the connection request is being received from an instant message gateway server" specifically means in the recited context, as the claim already recites the connection request is from a user. Is it determining whether the connection request is being received via an instant message gateway server, but still from the user? Or is it

determining that it is received from an instant message gateway server, and therefore not a user? The later interpretation makes the claim indefinite as it contradicts the previous limitation that the request is received from a user.

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Gazzetta et al (US Pub. No. 2004/0083297), hereafter "Gazzetta."

17. As to claim 11, Gazzetta discloses a method comprising:

receiving at a gateway server, a public instant message (IM) service connection request from a user ([0037], lines 4-8, authentication server (gateway server) receives authentication request);

the gateway server verifying that the user is authorized to access the gateway server ([0037], lines 4-8);

the gateway server verifying that the user is authorized to participate in public IM communications ([0038], lines 10-15 and [0039], lines 7-17, authentication

server (gateway server) verifies via the service provider (through a series of exchanges) that the user is authorized to connect with the service provider (public IM communications)).

modifying the public IM service connection request to include data that identifies the gateway server ([0038], lines 5-12);

and forwarding the public IM service connection request to a public IM service ([0038], lines 5-12).

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tock et al (US Pub. No. 2006/0242241), hereafter "Tock," in view of Gazzetta.

20. As to claim 1, Tock discloses a method by a public service comprising:

the public service receiving via a client application a request from a user to connect to an email service ([0051], lines 7-13, intermediary server (provides public service as it is available over the Internet, Fig. 1B, label 158) receives

request from user to access resources (resources including email Fig. 1B, label 168);

the public service determining that the user is associated with a particular domain ([0051], lines 13-17); and

based on a determination that the user is associated with the particular domain, the public service redirecting the request to an email gateway server that is associated with the domain ([0051], lines 9-21, user accesses mail server (Fig. 1B, label 168) associated with a private network).

But, Tock does not disclose the public service is an IM public service and the email gateway server is an IM gateway server.

However, Gazzetta discloses associating a public IM service with enterprise IM services that includes linking enterprise IM accounts with public IM accounts ([0026]) thereby allowing enterprise users to chat with users on both their own enterprise IM network and the public IM network ([0026], lines 14-16).

Therefore the combination of Tock and Gazzetta would have been obvious because as one of ordinary skill in the art would view email and instant messaging as analogous arts (in that they both deal with electronic communication between users and involve the communication of primarily text based messages) and as a person of ordinary skill has good reason to pursue



the known options within his or her technical grasp. Specifically, as Tock discloses allowing access to private email accounts over a public network (Tock, Abstract), and Gazzetta discloses linking public IM accounts with private IM accounts (Gazzetta, [0026]), the combination would yield a system to access private IM accounts via a public IM service and would led to anticipated success (as Gazzetta discloses access to a public IM service via a private IM service, the converse would have been obvious and successful in view of Tock's disclosure of such a system in regards to email) brought about not by innovation, but of ordinary skill and common sense.

21. As to claim 9, Tock discloses a method implemented by a public service comprising:

the public service receiving a user request to connect to an email service ([0051], lines 7-13, intermediary server (provides public service as it is available over the Internet, Fig. 1B, label 158) receives request from user to access resources (resources including email Fig. 1B, label 168);

the public service determining a domain associated with the user request ([0051], lines 13-17); and

the public service accessing domain-specific policy data associated with the domain (Fig. 5 and [0064], requests must be approved based on established access privileges);

in an event that the domain-specific policy data indicates that connection requests associated with the domain are not allowed, the public service denying the request to connect to the public service based on the domain specific policy data (Fig. 5, labels 504 and [0064]);

But, Tock does not disclose the public service is an IM public service.

However, Gazzetta discloses associating a public IM service with enterprise IM services that includes linking enterprise IM accounts with public IM accounts ([0026]) thereby allowing enterprise users to chat with users on both their own enterprise IM network and the public IM network ([0026], lines 14-16).

Therefore the combination of Tock and Gazzetta would have been obvious because as one of ordinary skill in the art would view email and instant messaging as analogous arts (in that they both deal with electronic communication between users and involve the communication of primarily text based messages) and as a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. Specifically, as Tock discloses allowing access to private email accounts over a public network (Tock, Abstract), and Gazzetta discloses linking public IM accounts with private IM accounts (Gazzetta, [0026]), the combination would yield a system to access private IM accounts via a public IM service and would led to anticipated success

(as Gazzetta discloses access to a public IM service via a private IM service, the converse would have been obvious and successful in view of Tock's disclosure of such a system in regards to email) brought about not by innovation, but of ordinary skill and common sense.

22. As to claim 2, Gazzetta discloses:

the public IM service identifying a user ID associated with the request ([0039], lines 4-7);

the public IM service determining a domain associated with the user ID ([0039], lines 4-7); and

the public IM service determining that requests for connections to the public IM service from users associated with the domain are to be redirected ([0041], lines 16-19).

23. As to claim 3, Gazzetta and Tock disclose determining a redirection address associated with the domain, the redirection address being associated with the IM gateway server; and transmitting a transfer command to a client application from which the request was received, the transfer command indicating the redirection address to which the request is to be submitted (Tock, [0051], lines 7-20, as the intermediary server connects client applications to email server's redirection address is present).

24. As to claim 4, Gazzetta and Tock disclose the invention substantially with regard to the parent claim 3, and further disclose where the redirection address comprises at least one of an IP address (Tock, [0051], lines 7-20, as the intermediary server connects client applications to email server's redirection address is present).
25. As to claim 5, Gazzetta and Tock disclose the invention substantially with regard to the parent claim, and further disclose the redirection address further comprises a port number (Tock, inherent [0051], lines 7-20).
26. As to claim 6, Gazzetta discloses:
- the public service receiving via the client application another request to connect to the public IM service, the request being from the user and including an identifier that indicates that the request is being submitted from an IM gateway server that is associated with the domain ([0039], lines 1-7); and
- establishing through the IM gateway server, a connection between the public IM service and the client application ([0039], lines 7-17).
27. As to claim 7, Gazzetta discloses:
- the public service receiving instant message communications from the user through the IM gateway server ([0006], lines 1-7); and

the public service transmitting instant message communications directed to the user to the IM gateway server ([0070], lines 1-8).

28. As to claim 8, it is rejected by the same rationale set forth in claim 1's rejection.

29. As to claim 10, Gazzetta and Tock disclose:

in an event that domain specific policy data indicates that connection requests associated with the domain are to be redirected, the public IM service redirecting the request to connect to the public IM service based on the domain specific policy data (Tock, [0051], lines 7-20).

30. Claims 15, 17-26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gazzetta in view of Tock.

31. As to claim 15, Gazzetta discloses a system comprising:

a public instant message service configured to enable public instant message communications between two or more users ([0036], lines 11-13 and Fig. 2, label 210 the service provider (public instant messaging service), wherein the public instant message service comprises:

an instant message connect domain store configured to store domain names that identify domains for which instant message service connection requests are to be redirected ([0039], lines 1-7); and

a dispatch server configured to:

receive a connection request from a user through an instant message client application ([0038], lines 1-12 and [0039], lines 1-2);

determine whether the connection request is being received from an instant message gateway server ([0039], lines 1-7);

Gazzetta does not disclose:

in an event that the connection request is not being received from an instant message gateway server, determine whether the connection request is from a user associated with a domain identified in the instant message connect domain store; and

in an event that the connection request is from a user associated with a domain identified in the instant message connect domain store, issuing a transfer command to the instant message client application, the transfer command including a redirection address.

However Tock discloses:

a public service ([0051], lines 7-13, intermediary server (provides public service as it is available over the Internet, Fig. 1B, label 158) comprising:

an connect domain store configured to store domain names that identify domains for which email service connection requests are to be redirected ([0051], lines 11-21, "private corporate networks" would have

their own domains and thus the connection request goes the mail server);

and

a dispatch server configured to:

receive a connection request from a user ([0051], lines 7-13, intermediary server (provides public service as it is available over the Internet, Fig. 1B, label 158) receives request from user to access resources (resources including email Fig. 1B, label 168);

in an event that the connection request is not being received from an gateway server, determine whether the connection request is from a user associated with a domain identified in the connect domain store ([0051], lines 7-13, intermediary server receives user request from application (i.e. not from a gateway server) and will connect user to private network if authorized); and

in an event that the connection request is from a user associated with a domain identified in the connect domain store, issuing a transfer command to the client application, the transfer command including a redirection address ([0051], lines 7-20, as the intermediary server connects client applications to email server's redirection address are present).

Therefore the combination of Tock and Gazzetta would have been obvious because as one of ordinary skill in the art would view email and instant

messaging as analogous arts (in that they both deal with electronic communication between users and involve the communication of primarily text based messages) and as a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. Specifically, as Tock discloses allowing access to private email accounts over a public network (Tock, Abstract), and Gazzetta discloses linking public IM accounts with private IM accounts (Gazzetta, [0026]), the combination would yield a system to access private IM accounts via a public IM service and would led to anticipated success (as Gazzetta discloses access to a public IM service via a private IM service, the converse would have been obvious and successful in view of Tock's disclosure of such a system in regards to email) brought about not by innovation, but of ordinary skill and common sense.

32. As to claim 30, it is rejected by the same rationale that was set forth in claim 15's rejection.

33. As to claim 17, Gazzetta and Tock disclose the invention substantially with regard to the parent claim 16, and further disclose the instant message connect domain store is configured to store at least one or an instant messaging ID/Key pair (Gazzetta, [0039], lines 1-7).



34. As to claim 18, Gazzetta and Tock disclose the invention substantially with regard to the parent claim 16, and further disclose a connection server configured to establish and maintain a connection between the instant message service system and the user through an instant message gateway server (Gazzetta, [0041], lines 16-22).
35. As to claim 19, Gazzetta and Tock disclose the invention substantially with regard to the parent claim 16, and further disclose a switchboard server configured to route instant message communication data received from and directed to the user (Gazzetta, Abstract).
36. As to claim 20, Gazzetta discloses the public IM service further comprises an enterprise-specific data log configured to store data associated with public IM communications directed to or from a user associated with a particular enterprise ([0070], lines 1-3 and [0006], lines 1-3).
37. As to claim 21, Gazzetta discloses data log is implemented as a component of an enterprise network that is separate from the public instant message service ([0070], lines 1-3 and [0006], lines 1-3).
38. As to claim 22, Gazzetta discloses the data log is implemented as a database ([0070], lines 1-3).

39. As to claim 23, Gazzetta discloses an enterprise instant message gateway server configured to manage public instant message conversations in which an enterprise user participates ([0006], lines 1-7).
40. As to claim 24, Gazzetta discloses the public instant message service is further configured to verify that the gateway server is a valid gateway server associated with an enterprise with which the user is associated ([0039], lines 1-7).
41. As to claim 25, Gazzetta discloses:
- request a connection to the public instant message service on behalf of the enterprise user ([0039], lines 1-4); and
  - route instant message conversation data between the public instant message service and the enterprise user ([0006], lines 1-7).
42. As to claim 26, Gazzetta discloses the enterprise instant message gateway server is further configured to generate a log of the instant message conversation data ([0070], lines 1-3).
43. Claim 13-14, 27-29, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gazzetta and Tock as applied to their parent claims above, and further in view of what was well known in the art at the time of the invention.

44. As to claim 13, Gazzetta does not explicitly disclose the verifying comprises examining data stored in an enterprise policy and configuration data store.

However, Gazzetta does disclose the advantages of enterprise management with regards to instant messaging ([0006], lines 1-7) and to one of ordinary skill in the art at the time of the invention it would be obvious to store explicit policies in order to manage the enterprise. Further, Gazzetta system allows communication between the enterprise network and the public IM network it would have been obvious to have policies that manage such interactions. Therefore, Official Notice is taken (MPEP 2144.01) that implementing verification policies in order to restrict access to the use of the enterprise IM system is an obvious modification done in order to improve the security of the system.

45. As to claim 14, Gazzetta discloses establishing point-to-point communications, enabled through the public IM service ([0021]).

But, Gazzetta does not explicitly disclose determining if the user is authorized to participate in point-to-point communications (aside from a general verification to use the system as a whole) and further if they are not authorized, altering the connection request to indicate such.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to make such modifications given the purpose of Gazzetta's invention ([0006], lines 1-7) and what is known and practiced in the art, i.e. restricting uses of resources in an enterprise network. Therefore, Official Notice is taken (MPEP 2144.01) that explicitly preventing point-to-point communications in order to improve security of the system is an obvious modification.

46. As to claims 27 and 28, Gazzetta does not explicitly disclose multiple gateway servers, distributed across an enterprise network, where users are routed to the nearest server in order to establish connections.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have multiple distributed IM authentication servers, especially if the enterprise network was a large network, as this is a common practice. Therefore, Official Notice is taken (MPEP 2144.01) that using a known practice (distribution of servers in order to improve response times) is an obvious modification of Gazette's system.

47. As to claim 29, it is rejected by the same rationale set forth in claim 13's rejection.

48. As to claim 32, Gazzetta and Tock disclose the invention substantially with regard to the parent claim, and but do not explicitly disclose denying connection requests for users not associated with a domain and denying connection requests for a user whose is associated with a unauthorized domain.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to make such modifications to Gazzetta and Tock given the purpose of Gazzetta's invention ([0006], lines 1-7) and what is practiced in the art, i.e. denying connections from suspicious domains or users who have undefined domains as they are security risks. Therefore, Official Notice is taken (MPEP 2144.01) that using a known practice (denying suspicious connection requests) is an obvious modification of Gazette's and Tock's system.

49. As to claim 33, Gazzetta and Tock disclose the invention substantially with regard to the parent claim, and further disclose in an event that the user is not associated with a domain for which connection requests are to be denied:
- authenticate an identity of the client application through which the user submitted the connection request (Gazzetta, [0037], lines 4-8); and
  - establish a connection between the user and the public instant message service (Gazzetta, [0041], lines 16-19 and [0036], lines 11-13).

***Conclusion***

50. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.
51. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
52. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. J. D./  
Examiner, Art Unit 2152

/Bunjob Jaroenchonwanit/  
Supervisory Patent Examiner, Art Unit 2152

